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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/543,952	04/06/2000	Arthur R. Francis	RSW9-2000-0008-US1	7895
7590 12/28/2005			EXAMINER	
Jeanine S Ray-Yarletts IBM Corporation T81/062 P O Box 12195 Research Triangle Park, NC 27709			VAUGHN, GREGORY J	
			ART UNIT	PAPER NUMBER
			2178	
DATE MAILED: 12/28/2005				

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/543,952

Applicant(s)

FRANCIS ET AL.

Examiner

Gregory J. Vaughn

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 06 October 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-31 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-31 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date. _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Action Background

1. This action is responsive to the applicant's response, filed on 10/6/2005.
2. Claims 1-31 are pending in the case, claims 1, 8, 15 and 22 are independent claims.
3. No claims were amended with this response.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

"A person shall be entitled to a patent unless –

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made."

5. Claims 1, 6, 7, 8, 13, 14, 15, 20-22, 27 and 28 remain rejected under 35 U.S.C. 103(a) as being unpatentable over Hawkins et al. US Patent 6,343,318, filed 5/29/1998, patented 1/29/2002 (hereinafter Hawkins) in view of Ginter et al., US Patent 5,892,900, filed 8/30/1996, patented 4/6/1999 (hereinafter Ginter).

6. **Regarding independent claim 1**, Hawkins discloses in Figure 1 receiving a request for the original JSP file at a server, the request being sent from a PvC device, the JSP file being stored at the server. As shown in Figure 1, the PvC device is shown at reference sign 100 (described as "*Wireless Communications Device*"), the request is shown at reference signs 122, 124 and 126 (described as "*Wireless CTP Query*", "*CTP Query*" and "*HTTP Query*" respectively), and the server is shown at reference sign 140 (described as "*Web Server*"). The server is shown storing a document at reference sign 144 (described as "*HTML Page*"). Hawkins anticipates the HTML page stored at the server as also being embodied as JSP, as described in the next paragraph.

Hawkins recites: "*The proxy server 180 responds to requests by wireless clients 405 to fetch either web content or messaging information. The proxy server 180 carries most of the burden of bringing the information from the Internet 190, converting it to wireless client 405 compatible CTP and CML formats, and transferring it to the wireless client 405 over the wireless network*" (column 261, lines 17-23) and "*The wireless client 405 and the proxy server 180 use a special format for transferring screen 101 contents from the proxy server 180 to the wireless client 405. This format, named Compact Markup Language (CML), emphasizes compactness over readability and generally uses variable length binary bit fields instead of text to represent options and formatting information*" (column 21, lines 33-40). Hawkins further recites: "*CGI (Common Gateway Interface) scripts can be supported. CGI*

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scripts are used by the web server 140 to respond to form submissions by browsers and for customizing web content for a particular user. When the browser 104 requests a web document that corresponds to a CGI script, the browser 104 can append text parameters to the end of the base document URL. The proxy server 180 will parse the parameters out" (column 13, lines 44-51) and *"Alternatively, the wireless applications can standalone applications access through the browser 104. The applications can be C programs, JAVA programs, and/or compressed markup language (CML) or HTML pages"* (column 9, lines 34-37). Hawkins also recites: *"The wireless application 106 represents one of many predefined applications that are stored locally on the wireless communications device 100"* (column 9, lines 15-17).

Hawkins discloses performing the conversion process steps at the server. Hawkins recites: *"server 180 carries most of the burden of bringing the information from the Internet 190, converting it to wireless client 405 compatible CTP and CML formats, and transferring it to the wireless client 405 over the wireless network"* (column 261, lines 18-23).

Hawkins discloses transforming a Java proxy server file application into a pervasive computing device compatible file, where the server will parse specific elements out during the conversion process. Hawkins also discloses storing the transformed file. Hawkins fails to disclose the masking and unmasking of specific tags in the conversion process. Ginter teaches the use of masking tags. Ginter recites: *"UDEs 1200 are preferably encrypted using a*

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site specific key once they are loaded into a site. This site-specific key masks a validation tag" (column 150, lines 35-37).

Therefore, it would have been obvious, to one of ordinary skill in the art, at the time the invention was made, to combine the masking of tags as taught by Ginter with the transformation of files for pervasive computing devices as taught by Hawkins in order to "*maintain the integrity, availability, and/or confidentiality of such information and processes related to such use*" (Ginter, column 1, lines 13-15).

7. **Regarding independent claims 8, 15 and 22**, the claims are directed toward an apparatus, a computer program and a system (respectively) for the method of claim 1, and remain rejected using the same rationale.
8. **In regard to dependent claims 6-7, 13-14, 20-21 and 27-28**, the claims remain rejected for fully incorporating the deficiencies of their base claims.
9. Claims 2, 3, 9, 10, 16, 17, 23 and 24 remain rejected under 35 U.S.C. 103(a) as being unpatentable over Hawkins in view of Ginter and further in view of Judson US Patent 6,185,586 (filed 4/6/1998, patented 2/6/2001).
10. **In regard to dependent claims 2 and 3**, Hawkins discloses transforming a Java proxy server file application into a pervasive computing device compatible file, where the server will parse specific elements out during the conversion process. Hawkins also discloses storing the transformed file. Hawkins and Ginter disclose masking as described above. Hawkins and

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Ginter fail to disclose masking by use of comment tags. Judson teaches the use of comments tags to mask. Judson recites: "*Preferably, the information object is masked by an HTML comment tag, which may include other HTML tags nested therein to format the information in the object*" (column 3, lines 2-3).

Therefore, it would have been obvious, to one of ordinary skill in the art, at the time the invention was made, to combine the transformation of files for pervasive computing devices by masking tag as taught by Hawkins and Ginter with the comment masking of Judson so that "*the information is preferably "hidden" within the web page using a hypertext markup comment tag*" (Judson, column 2, lines 58-59).

11. **Regarding dependent claims 9-10, 16-17 and 23-24**, the claims are directed toward an apparatus, a computer program and a system (respectively) for the method of claims 2-3, and remain rejected using the same rationale.
12. Claims 4-5, 11-12, 18-19 and 25-26 remain rejected under 35 U.S.C. 103(a) as being unpatentable over Hawkins in view of Ginter and further in view of Ramaley et al. US Patent 6,585,777, filed 1/19/1999, patented 7/1/2003 (hereinafter Ramaley).
13. **In regard to dependent claim 4 and 5**, Hawkins discloses transforming a Java proxy server file application into a pervasive computing device compatible file, where the server will parse specific elements out during the

conversion process. Hawkins also discloses storing the transformed file. Hawkins and Ginter disclose masking as described above. Hawkins and Ginter fail to disclose storing with a unique file name or file extension. Ramaley discloses "*Assign Unique Identifier Comprising Fixed String and Unique Instance Number*" at reference 620 in Fig. 6. Ramaley teaches the use of unique file naming

Therefore, it would have been obvious, to one of ordinary skill in the art, at the time the invention was made to add the file naming of Ramaley to the transformation of files for pervasive computing devices by masking tag as taught by Hawkins and Ginter to provide the benefit of "*placing information in a primary file that provides a cue*" (Ramaley, column 3, lines 7-8).

14. **In regard to dependent claims 11-12, 18-19 and 25-26**, the claims are directed toward an apparatus, a computer program and a system (respectively) for the method of claims 4-5, and remain rejected using the same rationale.
15. Claims 29-31 remain rejected under 35 U.S.C. 103(a) as being unpatentable over Hawkins in view of Ginter and further in view of Toyouchi et al. US Patent 6,847,988, filed 9/13/1999, patented 1/25/2005 (hereinafter Toyouchi).
16. **Regarding dependent claim 29**, Hawkins and Ginter disclose a method for transforming an original JSP file into a PvC device specific file, and locating the original JSP file on the server as described above. Hawkins and

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Ginter fail to disclose determining the type of PvC device based upon the header information of the request. Toyouchi discloses using the header information of a request to determine the type of device, Toyouchi recites: "*In FIG. 53, there is shown a format of a message transmitted/received between the information acquiring computer and the service providing computer. The message contains a header portion 701 and a data portion 702. The header portion 701 contains a destination address 7011, a source (sender) address 7012, a session ID 7013 capable of uniquely discriminating a session start to an end from the client application (browser), namely a combination with an address (for instance, IP address+port) and a time instant, a serial number 7014 within a session, a terminal sort 7015 for indicating a type of a terminal*" (column 38, line 66 to column 39, line 9).

Therefore, it would have been obvious, to one of ordinary skill in the art, at the time the invention was made, to combine the use of identifying information contained in the header of a request, as taught by Toyouchi, with the JSP to PvC transforming method of Hawkins and Ginter in order to provide "*more effective information service utilization by end users*" (Toyouchi, column 2, line 47).

17. **Regarding dependent claims 30-31**, the claims are directed toward a computer program and a system (respectively) for the method of claims 29, and remain rejected using the same rationale.

Response to Arguments

18. Applicant's arguments filed 10/6/2005 have been fully considered but they are not persuasive.
19. **Regarding claim 1**, the applicant recites: "*The Patent Office has not produced a prima facie case of unpatentability against this claim for at least three reasons. First, the suggested combination of Hawkins and Ginter would not meet the features of the claimed invention. Second, one of ordinary skill in the art would recognize that Hawkins teaches away from the masking steps of Ginter when converting files to a format compatible with pervasive computing devices. Finally, one of ordinary skill in the art would not combine these references when they are looked at as a whole.*" (page 13, second paragraph of the response filed 10/6/2005). Applicant is directed to the rejection of claim 1, as restated above.

In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, Ginter provides motivation to combine the masking of tags as taught by Ginter with the transformation of files for pervasive computing devices as taught by Hawkins

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in order to *"maintain the integrity, availability, and/or confidentiality of such information and processes related to such use"* (Ginter, column 1, lines 13-15).

Conclusion

20. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

21. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Gregory J. Vaughn whose telephone number is (571) 272-4131. The examiner can normally be reached Monday to Friday from 8:00 am to 5:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Stephen S. Hong can be reached at (571) 272-4124.

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The fax phone number for the organization where this application or proceeding is assigned is (571) 272-2100.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Gregory J. Vaughn
December 19, 2005



STEPHEN HONG
SUPERVISORY PATENT EXAMINER